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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,536

07/18/2005

Donna Hui-Ing Hwang

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EXAMINER

SOROUGH, LAYLA

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/542,536	Applicant(s) HWANG ET AL.	
	Examiner LAYLA SOROUGH	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2009 and 02 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The response filed March 12, 2009 and February 2, 2009 presents remarks and arguments submitted to the office action mailed October 31, 2008 is acknowledged.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claims 10, 13-14, and 16, 20 over Mackles (WO 86/05389 – IDS (previously presented)) view of Robinson (2003/0049212), Schreiber(4187287), and Mcosker et al. (2001/0003565) is not persuasive. However, in view of the amended claims a modified rejection is made herewith.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claim 15 over Mackles (WO 86/05389 – IDS (previously presented)) view of Robinson (2003/0049212), Schreiber(4187287), and Mcosker et al. (2001/0003565), as applied to claims 10, 13-14, and 16, 20 above, and further in view of Bergmann et al. (6,274,128 previously presented) is not persuasive. However, in view of the amended claims a modified rejection is made herewith.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claims 17, 18, and 19 Mackles (WO 86/05389 – IDS (previously presented)) view of Robinson (2003/0049212), Schreiber(4187287), and Mcosker et al. (2001/0003565), as applied to claims 10, 13-14, and 16, 20 above, and further in view of Mackles et al. (US Pat. No. 5,322,683 (previously presented) is not persuasive. However, in view of the amended claims a modified rejection is made herewith.

The rejections are modified below to address the amended claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 13-14, and 16, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackles (WO 86/05389 – IDS (previously presented)) view of Robinson (2003/0049212), Schreiber(4187287), Mcosker et al. (2001/0003565), and Magauran et al. (US 5340390 A).

Mackles teaches in Example 1 Valfor 950 (zeolite) in 35%, Cabosil M-5 (thickener) in 0.5%, decaglycerol tetraoleate (emollient) in 6%, polyethylene glycol 400 dioleate (nonionic surfactant) in 2%, and partially hydrogenated soybean oil (triglycerides) in 51.20% (p.13 lines 9-17) of a composition. The delivery system of Mackles provides a soft, silky, and cosmetically elegant feel to the skin (p.3 lines 5-9).

The exemplified composition does not contain the specific zeolite with a Si/Al ratio in the range of 2-5:1 and thickeners as recited in claim 1.

Robinson teaches topical composition comprising zeolites. The preferred zeolites are, i.e., sodium silicoaluminates available from UOP Molecular Sieves (see examples 16-18 MOLSIV adsorbent 3A) and Zeolex 23A (Valfor 950) (p.3 [0050] and p.28 [0345]). The MOLSIV adsorbent 3A compounds meet the limitation for "a zeolite with a Si/Al ratio in the range of 2-5:1.

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Schreiber is solely used to show that the type and amount of zeolite is the cause for variation in the rise of temperature in water. More specifically, the composition comprising zeolite 3a showed a change in temperature of 8C (col 11 and 12).

Mcosker et al. teaches suspending agents are inclusive of untreated fumed silica (Cabosil M-5) and castor oil derivatives.

Magauran et al. is solely used to show that castor oil derivatives include castor wax.

It would be obvious to one of ordinary skill in the art to substitute the Valfor 950 for MOLSIV adsorbent 3A and Cabosil M-5 for castor oil derivatives. The motivation to make such a substitution is because both zeolites and thickening agents are taught to be useful in topical compositions, furthermore, the zeolites provide heating properties and the thickeners provide various suspension properties. Therefore, a skilled artisan would have reasonable expectation of producing a stable topical composition with desired heating and suspension properties. Additionally, the determination of optimal or workable percentage of zeolites by routine experimentation is obvious. One having ordinary skill in the art would have been motivated to do this to obtain the desired heating properties of the composition.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mackles (WO 86/05389 – IDS (previously presented)) view of Robinson (2003/0049212), Schreiber(4187287), Mcosker et al. (2001/0003565), and Magauran et al. (US 5340390

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A)as applied to claims 10, 13-14, and 16, 20 above, and further in view of Bergmann et al. (6,274,128 previously presented).

Mackles is as discussed above.

Mackles fails to teach the specific dispersed oil caprylic/Capric triglyceride.

Bergmann et al. teaches a self-warming hair conditioning composition wherein conditioners of the composition are hydrocarbons inclusive of caprylic/Capric triglyceride and wax (col 4, lines 50-67 and col 5, lines 1-5).

It would be obvious to one of ordinary skill in the art at the time of the invention to incorporate caprylic/Capric triglyceride into a self-warming hair composition. The motivation to make such an incorporation is because the caprylic/Capric triglyceride and wax are conditioners. Hence, a skilled artisan would have reasonable expectations of successfully producing a self-warming hair conditioning composition with similar conditioning properties.

Claims 17, 18, and 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mackles (WO 86/05389 – IDS (previously presented)) view of Robinson (2003/0049212), Schreiber(4187287), , Mcosker et al. (2001/0003565), and Magauran et al. (US 5340390 A), as applied to claims 10, 13-14, and 16, 20 above, and further in view of Mackles et al. (US Pat. No. 5,322,683 (previously presented)).

Mackles is as discussed above.

Mackles fails to teach the method of cleansing as claimed.

Mackles ('683) teaches a self-heating foam composition comprising aluminosilicates useful as a hair conditioner and facial cleanser.

To a person with ordinary skill in the art at the time the invention was made it would be obvious to modify the self-heating foam composition to provide a facial cleansing composition. The motivation to make such a modification is because (1) both have similar compositions with similar self-heating foam properties, and, therefore, the interchangeable use of either one will successfully yield similar results.

Response to Arguments

Applicant's arguments filed January 12, 2009 have been fully considered but are not persuasive.

Applicant's arguments are drawn to limitations that were not previously presented. The modified rejections above address the new limitation.

Applicant argues "there would be no motivation or suggestion to substitute the Valfor 950 disclosed in Mackles WO for any zeolite falling within the claimed Si to Al ratio range." The Examiner states the secondary reference relied upon teach the equivalence of the zeolites Valfor 950 and MOLSIV adsorbent 3A.

With respect to the argument that the use of the MOLSIV zeolites provide surprising advantages which could not have been predicted from the prior art, the Examiner respectfully reiterates: Applicant's 132 Declaration has been considered but is not persuasive. The Schreiber reference above is solely used to show that the type and amount of zeolite is the cause for variation in the rise of temperature in water. More specifically, the composition comprising zeolite 3a showed a change in temperature of 8C (col 11 and 12). Hence, Applicants argument that the MOLSIV adsorbent 3A shows higher rise in temperature as opposed to the Valfor 950 is not an unexpected property

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of the known compound. Additionally, because both the MOLSIV and Valfor 950 compounds are known to be useful in topical formulations it would be obvious to one of ordinary skill in the art to substitute the Valfor 950 for MOLSIV adsorbent 3A. The motivation to make such a substitution is because both zeolites provide heating properties. Therefore, a skilled artisan would have reasonable expectation of producing a stable topical composition with desired heating properties.

Applicant argues the amount of emollient claimed is 10 to 25 wt% which imparts silk like feeling on the skin. Examiner states the delivery system of Mackles which includes the claimed emollient provides a soft, silky, and cosmetically elegant feel to the skin (p.3 lines 5-9).

The arguments are not persuasive and the rejection is made **FINAL**.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617

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